



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,069	12/17/2001	Andrea Maria Zamponi	1999/C-001	5624

7590

07/17/2003

Ashley I. Pezzner, Esquire
CONNOLLY BOVE LODGE & HUTZ LLP
1220 Market Street
P.O. Box 2207
Wilmington, DE 19899

EXAMINER

EINSMANN, MARGARET V

ART UNIT

PAPER NUMBER

1751

DATE MAILED: 07/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/022,069

Applicant(s)

ZAMPONI, ANDREA MARIA

Examiner

Margaret Einsmann

Art Unit

1751

-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 89-176 is/are pending in the application.
- 4a) Of the above claim(s) 89-136 and 157-176 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 137-156 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group V in Paper No. 10 is acknowledged. The traversal is on the ground(s) that since the examiner must examine Dye A in all cases, it would not be an undue burden to examine all of the claims. This is not found persuasive because all of the B dyes are completely different and require additional search. Additionally, the examination of an application is not limited to the prior art search, but includes examination of the application for basis, 112 problems, etc. which is a burdensome search in an application having so many claims, each of which contains multiple combinations of dyes having generic dyes comprising many species.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 137-156 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In response to this action, claim 137 needs to be drafted in independent form, including dye V and the definitions of all of its variables, while the non-elected claims are to be canceled. Claim 137 and its dependent claims are indefinite since Dye (V) is included in dye (A), when R^1 =phenyl substituted by sulfo and vinyl sulfone, and R^{14} is phenyl substituted by vinyl sulfone., both x and h=0, V=OH and W=NH₂. Accordingly, claim 89 and several dependent claims can be rejected on

Art Unit: 1751

the basis of a disclosure of dye A. The dyes defined as dye V in claims 138 and 139 also define dye A. Claims 154 –156 claim dyes within the scope of dye V. Accordingly “which contain” should be replaced with, “wherein the dye of formula V is...”

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 137-139 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ciba-Geigy, EP 149170. The dye of formula A is disclosed, along with several dyes within the scope of formula V, which are outside of the scope of formula A, for example, which are position isomers of dye of formula 1, since one of the sulfonic acid groups on the naphthyl may be in an alternative position; and the x may be one either phenyl group. Accordingly, patentee is teaching that all of the dyes of formula 1 in the abstract are equivalent. It would have been obvious to the skilled artisan to formulate mixtures of more than one dye of formula 1 since they are useful for the same purpose, and are all equivalent for dyeing of cellulosic fiber materials with good fastness to light and wet, and mixtures may be used to adjust the blue shade in order to match a desired shade.

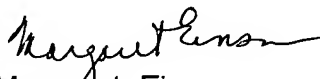
No art rejections are applied to the remaining dyes in the elected group. The art of record does not show mixing the specific dye of formula A with any other dyes in the group searched.

The IDS filed 1/30/2002 is in the file but the references are not. Accordingly only the IDS filed 3/19/2002 is returned.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret Einsmann whose telephone number is 703-308-3826. The examiner can normally be reached on 7:00 AM -4:30 PM M-Th and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on 703-308-4708. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


Margaret Einsmann
Primary Examiner
Art Unit 1751

July 14, 2003